UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/416,252	10/12/1999	DAVID R. TUSHIE	457.003US3	5923

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WANG, MARY DA ZHI

ART UNIT	PAPER NUMBER
2161	10

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

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	Application No.	Applicant(s)
Office Action Summary	09/416,252	TUSHIE ET AL.
	Examiner	Art Unit
	Mary D. Wang	2787

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will
  be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this
  communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on <u>12 October 1999</u> .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>25-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>25-44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

      1.☐ received.

      2.☐ received in Application No. (Series Code / Serial Number) _____ .

      3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Specification

1.   This application does not contain an abstract of the disclosure as required by 37

CFR 1.72(b). An abstract on a separate sheet is required.

2.   The disclosure is objected to because of the following informalities:

a) in "Related Applications" section, please add information to state that

Application No. 09/139,163 is now U. S. Patent No. 6,014,748.

Appropriate correction is required.

Claim Objections

3.   Claim 35 is objected to because of the following informalities:

a) on line 9 of claim 35 recites "using the data fields, and". The comma needs to

be replaced with a semicolon.

Appropriate correction is required.

4.   Claim 42 is objected to because of the following informalities:

a) on line 8 recites "a equipment --". "a equipment" should be "an equipment".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 25-34 are rejected under 35 U.S.C. 102(e) as being anticipated by

Dethloff et al., U. S. Patent No. 4,968,873.

As per claim 25, Dethloff teaches a method of processing data for a portable

programmed data carrier comprising (abstract):

a) acquiring personalization data for a cardholder (column 9 line 59-61);

b) acquiring personalization equipment characteristics for particular

personalization equipment (column 16 line 14-35 and Fig. 17 and Fig. 19-20);

c) creating instructions for an internal script from the personalization data

(column 11 line 1-27);

d) translating the internal script into a data stream in accordance with the

personalization equipment characteristics (Fig. 18 and Fig. 21).

As per claim 26, Dethloff teaches transferring the data stream to the particular

personalization equipment to issue the data carrier (column 15 line 64 – column 16 line

37 and Fig. 15-21).

As per claim 27, Dethloff teaches creating the instructions comprises mapping

the personalization data into a plurality of variables for the instructions (Fig. 9-14 and

Fig. 18).

As per claim 28, Dethloff teaches translating the internal script into a data stream

comprises translating the instructions into personalization equipment program

commands specified by the personalization equipment characteristics (Fig. 18).

As per claim 29, Dethloff teaches the internal script specifies a sequence in which the program commands will be performed by the personalization equipment (Fig. 18).

As per claim 30, Dethloff teaches acquiring information for a card application, and wherein at least one of the plurality of variables holds data for the card application (column 14 line 37 – column 15 line 63 and Fig. 11-13).

As per claim 31, Dethloff teaches the internal script includes instructions for a card operating system and further comprising:

a) acquiring programming control commands for a card operating system (column 10 line 56 – column 11 line 27 and column 12 line 45-50 and Fig. 2 and Fig. 9);

b) translating the instructions for the card operating system into the programming control commands (column 10 line 56 – column 11 line 27 and column 12 line 45-50 and Fig. 2 and Fig. 9).

As per claim 32, Dethloff teaches the internal script specifies a sequence in which the programming control commands will be executed by the card operating system (column 12 line 45-50 and Fig. 9).

As per claim 33, Dethloff teaches acquiring a security function, and adding the security function to the internal script (column 12 line 51-65 and Fig. 9 and Fig. 18 and Fig. 21).

As per claim 34, the instructions for the internal script are specified in a set of database records is inherent for such system.

As per claim 35, Dethloff teaches a computer-readable medium having stored thereon instructions to cause a computer to perform a method to issue a portable programmable data carrier, the method comprising (column 15 line 64 – column 16 line 13):

   a) determining if cardholder data is in an internal format is inherent for such system;

   b) interpreting cardholder data into a internal format if it is not in the internal format (column 5 line 41-46);

   c) mapping the internal format of the cardholder data into a plurality of data fields used by a card application (Fig. 9-14 and Fig. 18);

   d) creating a plurality of program commands for a particular personalization equipment using the data fields (Fig. 18);

   e) streaming the plurality of program commands to the particular personalization equipment to issue the portable programmable data carrier (Fig. 15-16 and Fig.18).

As per claim 36, Dethloff teaches the plurality of program commands reference data defining a microprocessor chip structure (column 1 line 28-30 and column 2 line 56-63 and column 10 line 56 – column 11 line 27 and Fig. 2).

As per claim 37, Dethloff teaches streaming programming control commands for a card operating system to the particular personalization equipment (Fig. 15-16 and Fig.18).

As per claim 38, Dethloff teaches a computer system comprising:

a) a processing unit (Fig. 17 and Fig. 20);

b) a computer-readable medium communicatively coupled to the processing unit (column 11 line 59 – column 12 line 5);

c) a smart card personalization system executing in the processing unit from the computer readable medium, wherein the smart card personalization system causes the processing unit to acquire a smart card definition, a card application definition, program commands for a particular personalization equipment, and cardholder data, and further causes the processing unit to map the cardholder data into data fields specified by the card application definition to create a script, to interpret the script into the program commands using the smart card definition, and to transfer the program commands to the particular personalization equipment to issue a smart card (Fig. 15-21).

As per claim 39, Dethloff teaches the smart card personalization system further causes the processing unit to acquire a format definition and to translate the cardholder data into a format specified by the format definition (Fig. 18 and Fig. 21).

As per claim 40, Dethloff teaches the smart card personalization system further causes the processing unit to acquire a card operating system definition and to interpret the script into programming control commands specified by the card operating system definition (Fig. 18 and Fig. 21).

As per claim 41, Dethloff teaches the smart card personalization system further causes the processing unit to acquire a security function and to add the security function into the script (column 12 line 51-65 and Fig. 9 and Fig. 18 and Fig. 21).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dethloff et al., U. S. Patent No. 4,968,873.

As per claim 42, Dethloff teaches a computer-readable medium having stored

thereon a smart card framework data structure comprising (Fig. 2):

a) a chip field containing data representing an identifier for a microprocessor

(column 11 line 5-6);

b) a master file field containing data representing information for the

microprocessor identified by the chip field (column 11 line 7-8).

c) a system file field containing data representing an address for a file in the

microprocessor identified by the chip field is inherent for such system.

As per claim 42, although Dethloff does not specifically state the data structure

further comprising an equipment field containing data representing an identifier for

personalization equipment used to program the microprocessor identified by the chip

field, it would have been obvious the data structure comprising such field. This would

have been obvious because in order for the smart card to communicate with a card

issuing machine (e.g. personalization equipment), the smart card must be able to

identify the machine first. Therefore, one of ordinary skill in the art would have

recognized the smart card must comprising an equipment field, which containing data representing an identifier for the machine.

As per claim 43, Dethloff teaches the computer-readable medium further comprising: an application field containing data representing an identifier for an application to be programmed into the microprocessor identified by the chip field (column 11 line 59 – column 12 line 5 and column 13 line 4-23 and Fig. 4a).

As per claim 44, Dethloff teaches the computer-readable medium further comprising: a security field containing data representing a security function for the application, identified by the application field (column 12 line 51 – column 13 line 64 and Fig. 9-11).

Double Patenting

9.   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

     A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

10.   Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2 of prior U.S. Patent No. 5,889,941. This is a double patenting rejection.

     Claims 35 and 38 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 and 19-23 of prior U.S. Patent No. 5,889,941. This is a double patenting rejection.

     Claim 42 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 24-26 of prior U.S. Patent No. 5,889,941. This is a double patenting rejection.

11.   Claims 1 and 35 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 10-13 of prior U.S. Patent No. 6,014,748. This is a double patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Wang whose telephone number is (703) 305-0084. The examiner can normally be reached Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reba Elmore, can be reached at (703) 305-9706. The fax number for this group is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose number is (703) 305-9618.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D. C. 20231

or faxed to:
(703) 308-9051 (for formal communications intended for entry)

or:
-    (703) 305-9724 (for informal or draft communications, please label "PROPOSED" or " DRAFT")

Hand-delivered responses should be brought Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Mary Wang
Patent Examiner
Art Unit 2787
June 7, 2000

REBA I. ELMORE
SUPERVISORY PATENT EXAMINER
GROUP 2700